

REMARKS

The Applicant respectfully requests reconsideration of the present application in view of the above changes to the claims and the following remarks, which are responsive to the Office Action mailed December 10, 2008.

I. Status of the Claims

In the Office Action, Claims 1-4, 6, 7 and 13-18 were noted as pending in the application and were rejected. As a result of this response, Claims 3, 4, 7 and 18 have been canceled, and Claims 1, 2, 6 and 13-17 remain pending.

II. Claim Rejections

a. 35 U.S.C. § 103(a)

In the Office Action, Claims 1-2, 6 and 13-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2001/0020242 to Gupta et al. ("*Gupta*") in view of U.S. Patent No. 6,505,254 to Johnson et al. ("*Johnson*") and further in view of U.S. Patent No. 7,298,327 to Dupray et al. ("*Dupray*"). (Office Action, pg. 3). In addition, Claims 3-4, 7 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gupta* in view of U.S. Patent No. 5,963,915 to Kirsch ("*Kirsch*") and further in view of *Dupray*. (Office Action, pg. 9).

i. Independent Claims 1 and 13

As noted above, independent Claims 1 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Gupta* in view of *Johnson* and further in view of *Dupray*. Applicant respectfully submits that none of these references, whether considered alone or in combination, teaches, suggests or makes obvious each of the recitations of Applicant's independent Claim 1 or 13. In particular, independent Claims 1 and 13 each recite "receiving by an external server on an external network a request for information from an Internet user through a proxy server; determining by the external server that the request for information is through the proxy server;

and redirecting by the external server the request for information to an internal server of a private network.” Applicant respectfully asserts that neither *Gupta* nor *Johnson* nor *Dupray*, whether considered alone or in combination, teaches or suggests at least these recitations of independent Claims 1 and 13.

The Office Action relies on *Gupta* as teaching the first and the third elements (i.e., receiving and redirecting). Applicant respectfully asserts, however, that *Gupta* does not in fact teach or suggest these recitations of independent Claims 1 and 13. In particular, independent Claims 1 and 13 recite three separate entities – a proxy server, an external server and an internal server – wherein the external server receives a request through the proxy server and redirects the request to the internal server. *Gupta* does not teach or suggest these three entities performing in this manner.

According to *Gupta*,

Proxies ... are usually owned and provided by a user’s ISP. To access the internet, the user establishes a connection with the ISP or proxy. The user or client then requests a URL from a web server. The proxy intercepts the request, searches its cache for the requested information and returns the information to the client if the information is in the proxy’s cache. If not in cache, the proxy communicates with the web server, retrieves the information, and forwards the information to the client.

Since the ISP or proxy is utilized to conduct all internet access, when a user views a web page or completes any transactions on the internet, each and every user action is processed through the ISP or a proxy of the ISP. Consequently, the ISP has the ability to maintain statistics on the user and the user’s internet viewing (referred to as user information or profile information) transparently to the user (without the user’s knowledge).

(*Gupta*, para. [0054-0055]).

In addition, according to *Gupta*,

a user or client 100 may roam into another ISP. This may occur when a user is traveling and dials into a phone number for a third party ISP or when the web browser utilizes the proxy of a third party ISP, for example. When client 100 roams into another ISP, the ISP may forward the request to the user’s home ISP for local advertisement insertion (as described below), the ISP may obtain the profile information from the user’s home ISP

and use it for advertisement insertion, or the user's roaming profile can be returned to the home ISP.

(*Id.* at para. [0060]).

As described above *Gupta* discloses two scenarios. In the first scenario, an ISP, *or a proxy to the ISP*, intercepts a request for a URL from a user and communicates with a web server to retrieve the requested information. This scenario does not involve the ISP receiving the request *through its proxy* and then transmitting the request to the web server – i.e., three separate entities (a proxy server, an external server and an internal server) are not involved. Instead, *Gupta* refers (here and throughout the specification) to the ISP and its proxy interchangeably, stating that “each and every user action is processed through the ISP *or a proxy of the ISP.*” (*Gupta*, para. [0055]). Accordingly, this scenario does not teach or suggest “receiving by an external server ... a request for information ... *through a proxy server,*” as recited in Applicant's independent Claims 1 and 13. There is further no teaching or suggestion that the ISP is on an external network, while the web server is on a private network. Thus, this scenario further does not teach or suggest “receiving by an external server *on an external network* a request ... [and] redirecting by the external network the request for information to an internal server *of a private network.*”

Turning to the second scenario described by *Gupta*, in this scenario, a third party ISP *or a proxy to the third party ISP*, intercepts the request and communicates with a home ISP in order to obtain profile information to be used to insert advertisements into the information requested by the user. As with the first scenario, this scenario likewise does not involve the third party ISP receiving the request *through its proxy*. In contrast, *Gupta* discloses *either* the third party ISP *or* its proxy intercepting the request and communicating with the home ISP to obtain the profile information (i.e., the third party ISP and its proxy are again used interchangeably). Accordingly, this scenario does not teach or suggest “receiving by an external server ... a request for information ... *through a proxy server,*” as recited in Applicant's independent Claims 1 and 13.

As described above, and as disclosed throughout *Gupta*, *Gupta* does not teach or suggest the ISP/third party ISP receiving a request *through a proxy*, and, instead refers to the ISP/third

party ISP and the proxy to the ISP/third party ISP interchangeably. To further illustrate, reference is made to the figures of *Gupta* and, in particular to Figures 3 and 4, which are reproduced below for the Examiner's convenience.

Figure 3

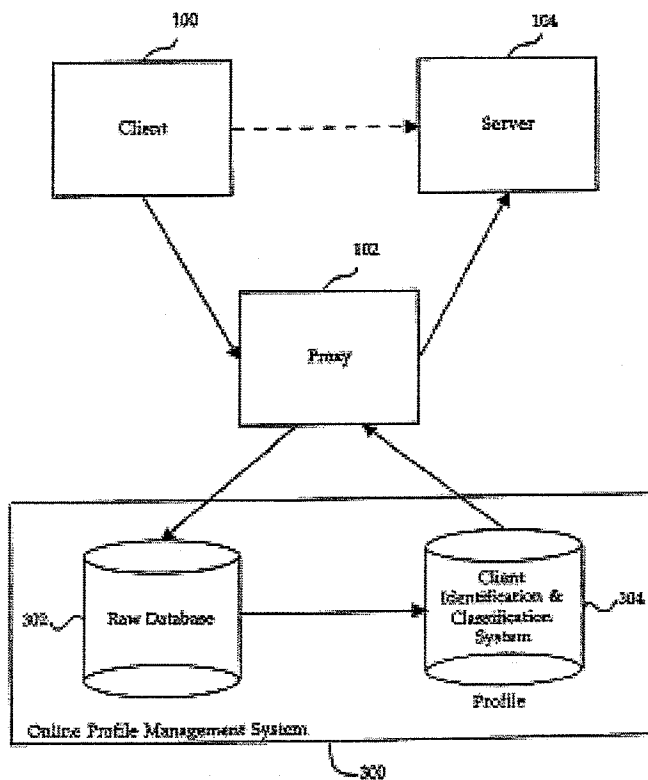
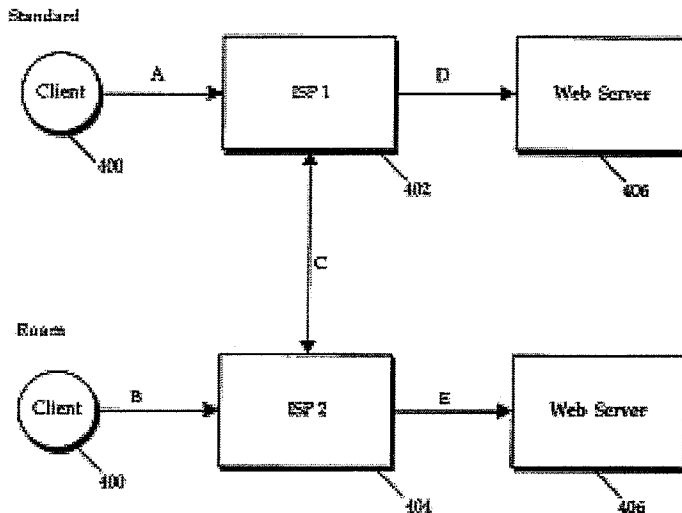


Figure 4



Applicant notes that none of the figures of *Gupta* illustrate both an ISP/third party ISP and a proxy to the ISP/third party ISP. In particular, none of the figures illustrate the ISP/third party ISP receiving something from a user/client via a proxy. Instead, each figure illustrates either the ISP/third party ISP (e.g., Figure 4), or the proxy (e.g., Figure 3). This just provides further evidence that *Gupta* describes the functionality of these entities interchangeably and does not teach or suggest the ISP/third party ISP receiving a communication via its proxy.

Based on the foregoing, Applicant respectfully asserts that *Gupta* does not teach or suggest “receiving by an external server on an external network a request for information from an Internet user through a proxy server; ... [or] redirecting by the external server the request for information to an internal server of a private network[.]” as recited in Applicant’s independent Claims 1 and 13.

Johnson and *Dupray* likewise fail to teach or suggest “receiving by an external server on an external network a request for information from an Internet user through a proxy server; ... [or] redirecting by the external server the request for information to an internal server of a private network[.]” In fact, the Office Action cites *Johnson* and *Dupray* for different purposes. In particular, the Examiner cites *Johnson* as teaching an “external router ... capable to recognize if

a request comes through a firewall in order to decide to redirect the request to internal router[.]" while citing *Dupray* as teaching a "method of determining and selecting location for target mobile station based in part on confidence level[.]" (Office Action, pg. 4). Since both of the cited references fail to teach or suggest "receiving by an external server on an external network a request for information from an Internet user through a proxy server; ... [or] redirecting by the external server the request for information to an internal server of a private network[.]" the cited references, even if combined, do not teach or suggest all of the recitations of independent Claim 1 or 13.

With regard to the second recitation, the Office Action concedes that *Gupta* does not disclose "determining by the external server that the request for information is through the proxy server[.]" (Office Action, pg. 4). As noted above, the Office Action relies on *Johnson* for this recitation of independent Claims 1 and 13. Applicant respectfully asserts, however, that the combination of *Gupta* and *Johnson* in this manner is improper.

In particular, the Examiner has the burden of establishing a prima facie case of obviousness under 35 U.S.C. § 103(a). Ex *Parte Martin P. Hageman and Thomas J. Palus*, Appeal No. 2000-1514, Application No. 09/038,450 (citing *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)); *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only if the Examiner satisfies this initial burden does the burden of coming forward with evidence shift to the Appellant. *Id.* The Examiner can satisfy this burden by showing some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

A prima facie case of obviousness requires: (1) a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; (2) a reasonable expectation of success; and (3) the prior art reference (or references when combined) must teach or suggest all

of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Fine*, 87 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); MPEP § 2142, 8th Ed., Rev. 4. Furthermore, rejections based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be explicit analysis including some rational underpinning to support the legal conclusion of obviousness. *K.S.R. International Co. v. Teleflex, Inc.*, et al., 550 U.S. 14 (April 2007), citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006).

Applicant respectfully asserts that the Examiner has not satisfied the first requirement for establishing a prima facie case of obviousness. In particular, Applicant respectfully asserts that even if *Johnson* discloses determining whether the request is through a proxy server (which Applicant does not concede), a person of ordinary skill in the art would not have been motivated to modify *Gupta* to include this recitation. In particular, *Gupta* states that "the ISP or proxy is utilized to conduct all internet access" and that "each and every user action is processed through the ISP or a proxy of the ISP." (*Gupta*, para. [0054], emphasis added). In other words, according to *Gupta* all request for information transmitted by a user to a web server are intercepted by the ISP/proxy. Accordingly, it would be unnecessary to determine whether the request was through a proxy server, since the answer would always be yes. As a result, a person of ordinary skill in the art would not have been motivated to modify *Gupta* to include the step of "determining by the external server that the request for information is through the proxy server[,]" and the modification of *Gupta* to include this recitation is improper.

For at least the reasons discussed above, Applicant respectfully submits that independent Claims 1 and 13 are patentable over *Gupta* in view of *Johnson* and further in view of *Dupray*. Applicant, therefore, respectfully requests that the rejection of independent Claims 1 and 13 be withdrawn.

ii. Dependent Claims 2, 6 and 14-17

Claims 2 and 6; and 14-17 depend, respectively, from independent Claims 1 and 13 and include all of the recitations of their base claims and any intervening claims plus their additional recitations that further distinguish the art applied in the rejection. Thus, for at least the reasons set forth above with respect to independent Claims 1 and 13, it is respectfully submitted that dependent Claims 2, 6 and 14-17 are further patentable over *Gupta* in view of *Johnson* and further in view of *Dupray* as such dependent claims now depend from allowable base claims.

III. Conclusion

In light of the remarks above, Applicant respectfully submits that the application is in condition for allowance and respectfully requests that a Notice of Allowance be issued. The Examiner is encouraged to contact Applicant's undersigned attorney to resolve any remaining issues in order to expedite examination of the present application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 14-0629.

Respectfully submitted,

/Jennifer F. Miller/
Jennifer F. Miller
Registration No. 56,278

Ballard Spahr Andrews & Ingersoll, LLP
Customer Number 23859
(678) 420-9300
(678) 420-9301 (fax)